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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,433	08/14/2001	Dennis Mendiola	YSAP.CHIKKA.PT6	8747
24943	7590	04/19/2006	EXAMINER	
INTELLECTUAL PROPERTY LAW GROUP LLP 12 SOUTH FIRST STREET SUITE 1205 SAN JOSE, CA 95113			LEZAK, ARRIENNE M	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/928,433

Applicant(s)

MENDIOLA ET AL.

Examiner

Arrienne M. Lezak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Examiner notes that Claims 1-7, 9-15, 17 & 19 have been amended, claims 16 & 20 have been canceled, and no new claims have been added. Claims not explicitly addressed herein are found to be addressed within prior Office Action dated 5 October 2005 as reiterated herein below.

Claim Objections

1. Claims 5-15 were objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependant claim. See MPEP § 608.01(n). Applicant argued that claims 5-15 should have been treated on the merits because of a preliminary amendment submitted on 14 August 2001, and Examiner respectfully disagrees on two grounds. First, Applicant did submit said preliminary amendment on 14 August 2001; however, Applicant submitted a second preliminary amendment on 29 October 2001, within which second preliminary amendment Applicant enclosed a copy of the original set of claims, and wherein, "The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application". See 37 C.F.R. § 1.121.

2. Additionally, and as further proof of Applicant's intent, Applicant has again amended claims 9 & 12-15 in response to the prior Office Action dated 5 October 2005, thereby negating Applicant's argument that the claims, as amended within Applicant's preliminary amendment dated 14 August 2001, were the claims as Applicant wanted

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them originally examined. Thus, Examiner finds that the Office Action dated 5 October 2005 was proper regarding treatment of Claims 5-15. That noted, Examiner finds that the set of claims, as currently amended within the Amendment dated 31 January 2006, overcome the previous objection, and thus, objection to the same is hereby withdrawn.

3. Claim 3 was objected to because Claim 3, as written, contained a typographical error. Applicant has corrected said typographical error, overcoming said objection, and as such objection to the same is hereby withdrawn.

Claim Rejections - 35 USC § 112

4. Claims 4 & 19 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner notes that Applicant has properly amended Claims 4 & 19, and as such, objection to the same is overcome and hereby withdrawn.

5. Claims 16 & 20 were rejected under 35 U.S.C. 112, second paragraph, as being omnibus type claims. Applicant has cancelled Claims 16 & 20, and as such, objection to the same is overcome and hereby withdrawn.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-15 & 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent US 6,938,069 B1 to Narayanaswamy in view of US Patent US 6,714,793 B1 to Carey in further view of Applicant Admitted Prior Art, (hereinafter, "AAPA").

8. Regarding Claims 1, 2, 9 & 17, Narayanaswamy discloses an instant messaging system and method comprising:

- an IM server having a plurality of clients with IM client applications of the same or different types, (Col. 4, lines 22-40 & Col. 5, lines 54-63),
(Examiner further notes that Narayanaswamy teaches a dialog buffer associated with a server-based meeting space, which dialog buffer is capable of storing messages, obviously upon a server, and wherein it would have been obvious to maintain instant messages on a separate IM server for purposes maximizing memory allocation as needed throughout the network.);
- a remote server(s), (per pending Claim 9), to which at least one of said clients is connected, (Col. 4, lines 22-40 & Col. 5, lines 54-63);
- a computer network interconnecting said IM server and said remote server(s) to provide IM communications there between, (Col. 4, lines 22-40 & Col. 5, lines 54-63);
- a buffer (dialog) server interconnected with said remote server(s), the interconnection providing for the communication of messages between

said buffer server and said remote server(s) in steady, timed flows with minimal latency and connection disruptions, (Col. 4, lines 22-40 & Col. 5, lines 54-63);

- said buffer (dialog) server also being interconnected with the IM server using a protocol compatible therewith [in a manner where message handshaking is not required to be performed sequentially] to accommodate higher latency and instability of the computer network there between, (Col. 4, lines 22-40 & Col. 5, lines 54-63); and
- said buffer server being optimally connected relative to both said IM server and said remote server(s) so as to maximize message throughput, (Col. 4, lines 22-40 & Col. 5, lines 54-63).

9. Though Narayanaswamy teaches a dialog buffer associated with a server-based meeting space, Narayanaswamy does not specifically enumerate wherein that portion of the computer network interfaced with the IM server is prone to latency and instability, and wherein said remote server utilizes a sequential message handshaking protocol for transmitting and receiving messages to and from the IM server, and whereby a confirmation of the successful transmission or receipt of a message is required to be received or sent by said remote server before a subsequent message is able to be transmitted or received, and wherein a sequential message handshaking protocol is also utilized between said buffer server and said remote server.

10. Applicant however, discloses wherein that portion of the computer network interfaced with the IM server is prone to latency and instability. (AAPA – Specification

p.4, lines 28-30), and wherein said remote server utilizes a sequential message handshaking protocol for transmitting and receiving messages to and from the IM server, whereby a confirmation of the successful transmission or receipt of a message is required to be received or sent by said remote server before a subsequent message is able to be transmitted or received, (AAPA – Specification p.3, lines 6-33), and whereby using a sequential message handshaking protocol corresponding to that used by said remote server between said buffer server and said remote server would have been obvious. Additionally, Examiner finds that Applicant discloses that a direct connection between the SMSC server and the IM server eliminates the need for a sequential message handshaking protocol, (AAPA – Specification p. 4, lines 18-20. The motivation to combine the AAPA into the Narayanaswamy system is to provide for the generation and transmission of various classes of messages, (Narayanasway – Col. 1, lines 61-64), wherein the incorporation of particular protocols and message confirmations would facilitate the same. Additionally, Examiner notes that AAPA is obviously well known in the art and thus applicable to the Narayanaswamy teachings as noted herein.

11. Though Narayanaswamy teaches a dialog buffer associated with a server-based meeting space, Narayanaswamy does not specify a buffer connected between the computer network and the remote server. Carey clearly teaches a buffer server connected between the computer network and the remote server, (Carey – Fig. 1; Col. 3, lines 18-67; & Col. 4, lines 1-5). It would have been obvious to incorporate the Carey system into the Narayanaswamy server-based meeting space, as motivated by Carey

which notes a need to provide the benefits to provide the benefits of instant messaging, immediate knowledge of another online status and real-time text communication, outside of a hardwired Internet system, specifically, within a wireless environment, (Carey – Col. 1, lines 50-58), such as remote access via a PDA or cell phone.

Additionally, Examiner notes that Carey clearly teaches preparation of message data per predefined protocol, which predefined protocol could obviously be any protocol capable of communicating the same, (i.e.: SMPP or CDMP), which protocols visibly provide the status of message deliveries, (Carey – Col. 3, lines 35-67; Col. 4, lines 1-5; & Col. 7, lines 12-18). Thus, Claims 1, 2, 9 & 17 are found to be unpatentable over the combined teachings of Narayanaswamy, Carey and AAPA.

12. Regarding Claims 3 & 18, the combined teachings of Narayanaswamy, Carey and AAPA are relied upon for those teachings noted herein. AAPA additionally teaches the use of a direct link between servers, (AAPA – Specification p.4), wherein it would have been obvious for the buffer server to be connected via a direct electronic link to the remote server so as to ensure the communication of messages between the buffer server and the remote server in steady, timed flows with minimal latency and connection disruptions. Thus, Claims 3 & 18 are found to be unpatentable over the combined teachings of Narayanaswamy, Carey and AAPA.

13. Regarding Claims 4 & 19, the combined teachings of Narayanaswamy, Carey and AAPA are relied upon for those teachings noted herein. Narayanaswamy further teaches wherein if the remote network is located in a highly reliable Internet exchange with a highly reliable Internet infrastructure, the buffer server is connected via the highly

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reliable Internet exchange and infrastructure to the remote server, (Col. 2, lines 10-30 & Col. 4, lines 57-62), (Examiner notes that Narayanaswamy clearly teaches a virtual server-based meeting with Internet capabilities, wherein location of all meeting based entities would obviously be on the Internet network or connected thereto). Thus, Claims 4 & 19 are found to be unpatentable over the combined teachings of Narayanaswamy, Carey and AAPA.

14. Regarding Claim 5, the combined teachings of Narayanaswamy, Carey and AAPA are relied upon for those teachings noted herein. AAPA additionally teaches wherein said remote server is an SMSC server of a GSM network and said client types connected to the SMSC server have SMS capability that is controlled and managed by said SMSC server to provide for SMS there between and IM between the SMSC server and the IM server, (AAPA – Specification p. 3). Thus, Claim 5 is found to be unpatentable over the combined teachings of Narayanaswamy, Carey and AAPA.

15. Regarding Claim 6, the combined teachings of Narayanaswamy, Carey and AAPA are relied upon for those teachings noted herein. AAPA additionally teaches wherein said sequential message handshaking protocol is CIMDZ, (AAPA – Specification p.3). Thus, Claim 6 is found to be unpatentable over the combined teachings of Narayanaswamy, Carey and AAPA.

16. Regarding Claim 7, the combined teachings of Narayanaswamy, Carey and AAPA are relied upon for those teachings noted herein. AAPA additionally teaches wherein said computer network interconnecting said IM server and said buffer server is

the Internet, (AAPA – Specification p.4). Thus, Claim 7 is found to be unpatentable over the combined teachings of Narayanaswamy, Carey and AAPA.

17. Regarding Claim 8, the combined teachings of Narayanaswamy, Carey and AAPA are relied upon for those teachings noted herein. AAPA additionally teaches wherein the IM server is located within a tier 1 Internet exchange, (AAPA – Specification p.4). Thus, Claim 8 is found to be unpatentable over the combined teachings of Narayanaswamy, Carey and AAPA.

18. Regarding Claim 10, the combined teachings of Narayanaswamy, Carey and AAPA are relied upon for those teachings noted herein. AAPA additionally teaches wherein the messages are communicated in streaming data between said buflkr server and the remote server in well-defined time increments or cycles or sporadically depending on when the messages become available to send, (AAPA – Specification p.3). Thus, Claim 10 is found to be unpatentable over the combined teachings of Narayanaswamy, Carey and AAPA.

19. Regarding Claim 11, the combined teachings of Narayanaswamy, Carey and AAPA are relied upon for those teachings noted herein. AAPA additionally teaches wherein the buffer server has sufficient memory to buffer up to 255 instant messages received from the remote server to accommodate latency and instability problems associated with the computer network connection to the IM server, (AAPA – Specification p.3). Thus, Claim 11 is found to be unpatentable over the combined teachings of Narayanaswamy, Carey and AAPA.

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20. Regarding Claim 12, the combined teachings of Narayanaswamy, Carey and AAPA are relied upon for those teachings noted herein. Narayanaswamy additionally teaches dialog buffer wherein it would have been obvious for said buffer to be mirrored within the buffer of said buffer server of the remote server for redundancy and store and forward purposes, (per Carey). Additionally, as noted herein, AAPA additionally teaches wherein the buffer server has sufficient memory to buffer up to 255 instant messages received from the communication buffer to accommodate different communication speeds between the buffer server and the remote server, (AAPA – Specification p.3). Thus, Claim 12 is found to be unpatentable over the combined teachings of Narayanaswamy, Carey and AAPA.

21. Regarding Claim 13, the combined teachings of Narayanaswamy, Carey and AAPA are relied upon for those teachings noted herein. Narayanaswamy additionally teaches a dialog buffer wherein in light of Carey, which teaches a look-up table/database and store and forward functionality, (Carey – Col. 4, lines 6-33 & Col. 7, lines 12-18), it would have been obvious for each buffer to comprise a circular array to contain the messages currently being processed by the instant messaging system at any one time, and wherein a plurality of statuses are recorded against each message to indicate its particular stage of communication between the IM server and the remote server, (Carey – Col. 6, lines 12-67 & Col. 7, lines 1-64). Thus, Claim 13 is found to be unpatentable over the combined teachings of Narayanaswamy, Carey and AAPA.

22. Regarding Claims 14 & 15, the combined teachings of Narayanaswamy, Carey and AAPA are relied upon for those teachings noted herein. Narayanaswamy

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additionally teaches a dialog buffer wherein in light of Carey, which teaches a look-up table/database, a store and forward functionality, a check status functionality and a resend functionality, (Carey – Col. 4, lines 6-33; Col. 6, lines 12-67; & Col. 7, lines 1-64), it would have been obvious for each buffer to maintain a synchronization means to reconstruct/resend messages, (per their status via the circular array – per pending Claim 15), that may have been lost in transit between the buffers as a result of an extended interruption to the computer network linking the same. Thus, Claims 14 & 15 are found to be unpatentable over the combined teachings of Narayanaswamy, Carey and AAPA.

Response to Arguments

23. Applicant's arguments filed 31 January 2006, have been fully considered but they are not persuasive. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made.

24. Regarding Applicant's argument that the Narayanaswamy patent only teaches a message delivered to only one intended participant and then removed upon that participants exit from the meeting space, Examiner respectfully disagrees that Applicant has cited only one specific embodiment. Moreover, Applicant failed to notice the embodiment described a single sentence earlier, which other embodiment clearly notes

a chat message maintained in a dialog buffer for the duration of the meeting and available to all participants, (Narayanaswamy – Col. 5, lines 55-58).

25. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Examiner has noted the motivation for reference combination herein. Regarding Applicant's argument that the combined references do not teach a buffer server/IM server connection protocol devoid of message handshaking, Examiner respectfully disagrees, as further noted herein above.

26. Examiner has addressed Applicant's Amendment, and has further rejected all claims, as noted herein above. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

27. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arrienne M. Lezak whose telephone number is (571)-272-3916. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571)-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Arrienne M. Lezak
Examiner
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